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In re Application of:
Michael K. Eschmann, et al.
Application No. 10/751,258
Filed: 31 December, 2003
For: COALESCING DISK WRITE BACK
REQUESTS

DECISION ON PETITION TO
WITHDRAW THE FINALITY OF
AN OFFICE ACTION

This paper provides the decision on the petition filed January 29, 2007 under 37 C.F.R. § 1.181 and M.P.E.P. § 706.07 to withdraw the finality of the Office action, mailed October 13, 2006.

The Petition is **GRANTED**.

Applicable Prosecution History

May 4, 2006	Request Continue Examination filed, including amendments to claims 1, 11, and 21.
June 7, 2006	First Office action after RCE. In the office action Office action, claims 1, 11, and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mason, Jr. (6,304,946). The dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mason in view of Mandal (U.S. Application 2003/0088713). These were the only two rejections in the first Office action.
August 10, 2006	Applicant replied to the First Office action. No amendments were made in this reply.
October 13, 2006	Examiner issued a final Office action. In the final Office action the examiner rejected claims 1-30 under 35 U.S.C. § 112 ¶ 1 and under

35 U.S.C. § 103(a) as being unpatentable over Mason in view of Mandel.

- November 3, 2006 Applicant filed a response to the final rejection, requesting that the examiner reconsider the finality of the Office action in view of the new § 112 and § 103(a) rejections. Additionally, the applicant amended the independent claims.
- November 27, 2006 Examiner issued an advisory action refusing to withdraw the finality of the Office action and refusing entry of the claim amendments.
- January 29, 2007 Instant Petition filed, requesting withdrawal of the finality of the office action mailed on October 13, 2006, and requesting entry of the amendment filed on November 3, 2006.

RELIEF REQUESTED

The Applicant respectfully that

1. The finality of the office action mailed on October 13, 2006 be withdrawn.
2. The amendment filed on November 3, 2006 be entered.

OPINION

Petitioner asserts that claims 1-30 were first rejected under 35 USC § 112 ¶ 1 in the final office action mailed October 13, 2006, and the independent claims were first rejected under 35 U.S.C. § 103(a) as being unpatentable over Mason in view of Mandel. Petitioner asserts that these new grounds of rejection were not necessitated by any amendment.

ANALYSIS

MPEP 706.07 sets forth that the examiner should never lose sight of the fact that in every case the applicant is entitled to a fair and full hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal; and that in making the final rejection, they [the grounds of rejection] must be clearly developed to such an extent that applicant may readily judge the advisability of appeal unless a single previous Office action contains a complete statement supporting the rejection.

Furthermore, MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

A review of the file indicates that the claims were not amended in Applicants' response filed on August 14, 2006 to the non-final action mailed on June 7, 2006. No Information Disclosure statements were filed by Applicant after the mailing of the non-final action mailed on June 7, 2006. However, examiner introduced new grounds of rejection in the final office action mailed October 13, 2006,

1) by rejecting the independent claims under 35 U.S.C. § 103(a) as being unpatentable over Mason in view of Mandel (they were originally rejected under 35 U.S.C. § 102(b) over Mason), and

2) rejecting all the claims 1-30 as being unpatentable under 35 USC § 112 ¶ 1 for the first time.

With regard to the propriety of the finality of the office action mailed October 13, 2006, examiner's position that "the new grounds of rejection as necessitated by their amendment in view of their apparent newly intended meaning as reveled within the applicant's current argument, and thereby considered to have sufficiently implicitly amended the claim's meaning and scope beyond that both previously considered and supported by the applicant's original disclosure" does not seem to be proper, since applicants arguments merely points out that while Mason is directed to sequential writes, the claims of the instant application are drawn to "writing back to a disk two **non-sequential** writes as one write operation". There does not seem to be any effort on the Applicants' part to redefine claim terminology as suggested by examiner.

Examiner states that "the applicant's more recent argument implicitly changes the meaning of the use of the term "operation" previously equated with "request" (which as taught may comprise multiple "write accesses"; as also taught by the reference), to apparently meaning that it may not, in apparent contradiction to that originally disclosed.". The term "Operation" was used by applicant in the originally filed claims. If examiner interpreted "Operation" to equate to "Request", such position should have been made known to applicant earlier in the prosecution so that the grounds of rejection may be clearly developed, and issues clearly defined before appeal.

For the above stated reasons, the petition is **GRANTED**. The finality of Office action mailed on October 13, 2006 is hereby withdrawn and the office action is changed to non-final Office action. Applicant's response filed on November 3, 2006 will be treated as a response to the non-final Office action, and the amendments filed with the response of November 3, 2006 will be entered, and the case forwarded to examiner for further action.


Jack Harvey, Director
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and Information Security